

**REMARKS**

The Examiner is thanked for his courtesies extended during the telephonic interview conducted on October 6, 2003, and for his assistance in advancing prosecution on the merits of the present application. During the telephonic interview, claim 1 and the U.S. Patent No. U.S. Patent No. 6,017,354 to *Culp* et al. were discussed. No agreement as to the patentability of the claims, and in particular claim 1, was reached during the telephonic interview. However, this amendment is being submitted in response to the conversation held with the Examiner to further emphasize those features of the present invention that are believed to be patentable.

Applicants acknowledge the allowance of claims 22, 35, 36, 41, and 42. Claims 1-46 are pending. The specification has been amended. Claims 1-3, 9, 10, 12, 17, 21-24, 32, 35-37, and 44 have been amended. No new matter has been added by way of this amendment. Reconsideration of the application is respectfully requested.

The specification has been amended to provide a description of blocks 411 and 412 (amended to 511 and 512, respectively) in the flow chart shown in Fig. 5A. Support for this amendment may be found on page 7, line 11 thru page 8, line 2 of the specification. Accordingly, no new matter has been added by way of this amendment.

Claims 1-12, 17, 21, 24-32, 34, 38-40, and 44-46 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,017,354 to *Culp* et al., while claims 18, 19, and 23 stand rejected under 35 U.S.C. 103(a) as being unpatentable over the same reference in view of U.S. Patent No. 5,400,267 to *Denen* et al. Claims 20, 24, 37, and 43 stand rejected under 35 U.S.C.

103(a) as being unpatentable over *Culp* et al. in view of U.S. Patent No. 6,331,181 to U.S. Patent No. 6,331,181 to *Tierney* et al. Claims 20 and 33 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Culp* et al. in view of U.S. Patent No. 6,298,255 to *Cordero* et al. Lastly, claims 13 and 16 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Culp* et al. in view of U.S. Patent No. 6,434,507 to *Clayton* et al.

In response to these several grounds of rejection, Applicants have amended independent claims 1-3, 9, 10, 12, 32, and 44 to emphasize those features of the invention that distinguish it from the cited references. Accordingly, for the reasons set forth hereafter, Applicants respectfully submit that all claims of record now distinguish over the cited references.

Independent claims 1-3, 9, 10, 12, 32, and 44 have been amended to recite the limitation that the generator console “instructs the hand piece to operate in different modes based on a handicap limit and a disable limit for all end-effectors which have been connected to the hand piece.” Support for this limitation may be found in the claims which have been indicated to contain allowable subject matter; namely claims 22, 35, 36, 41, and 42. Each of these claims relates to the feature of operating the hand piece in either a handicap mode or a disabled mode based on a count of all end effectors that have been (or is) connected to the hand piece. Accordingly, Applicants respectfully submit that this limitation does raise an issue that would require a new search and/or additional consideration, nor does the limitation introduce new matter.

U.S. Patent No. 6,017,354 to *Culp* et al. relates to an integrated surgical tool system for energizing different powered surgical handpieces (see *Abs.*).

Set forth on page 4, paragraph 7 of the Office Action is the statement that:

“An important aspect of Culp’s disclosure that the applicant should understand relates to Culp’s disclosure of an *ultrasonic surgical hand piece*. First of all, in the BACKGROUND OF THE INVENTION, Culp expresses that the reason for his invention - the problem to be solved - is that with all of the modern surgical tools now available it is expensive to keep separate generator consoles for each one [Column 1, lines 50-58]. He is setting out to provide a single integrated console that is able to accept tools having many *different power and controls requirements* [Column 3, lines 44-51] that will save time for surgical staff.” (*Emphasis Added*)

However, Applicants respectfully assert that *Culp et al.* fails to teach a generator console that “instructs the hand piece to operate in different modes based on a handicap limit and a disable limit for all end-effectors which have been connected to the hand piece,” as set forth and presently claimed.

U.S. Patent No. 5,400,267 to *Denen et al.* relates to a non-volatile memory disposed within electrically powered medical equipment is described (see *Abs.*). According to this patent, the non-volatile memory may be preprogrammed to store utilization limits and parametric data for the equipment. However, this reference fails to cure the deficiency of the *Culp et al.* patent. Specifically, the *Denen et al.* patent fails to teach a generator console that “instructs the hand piece to operate in different modes based on a handicap limit and a disable limit for all end-effectors which have been connected to the hand piece,” as set forth in the amended independent claims.

U.S. Patent No. 6,331,181 to *Tierney et al.* teaches robotic surgical tools, systems, and methods for preparing for and performing robotic surgery include a memory mounted on the tool (see *Abs.*). However, this reference fails to cure the deficiency of the *Culp et al.* patent. Specifically, the *Tierney et al.* patent also fails to teach a generator console that “instructs the hand

piece to operate in different modes based on a handicap limit and a disable limit for all end-effectors which have been connected to the hand piece,” as set forth in the amended independent claims.

U.S. Patent No. 6,298,255 to *Cordero* et al. teaches a sensor system which includes a biopotential signal monitor, a smart sensor and the accompanying hardware and software interface which authenticates the source and validity of the smart sensor and also verifies that the smart sensor meets various criteria for use (see *Abs.*). However, this reference fails to cure the deficiency of the combined *Culp* et al. and *Tierney* et al. patents. Specifically, the *Cordero* et al. patent also fails to teach a generator console that “instructs the hand piece to operate in different modes based on a handicap limit and a disable limit for all end-effectors which have been connected to the hand piece,” as set forth in the amended independent claims.

Lastly, U.S. Patent No. 6,434,507 to *Clayton* et al. relates to a system for generating images during medical and surgical procedures that indicate a change in the condition or configuration of a medical instrument being used, wherein the system provides a positive indication of the position of a removable or interchangeable portion of the instrument (see col. 1, lines 19-25). However, even when this reference is combined with the previously cited references, the claimed system is still not achieved. This is because the *Clayton* et al. patent also fails to teach a generator that “instructs a hand piece to operate in different modes based on a handicap limit and a disable limit for all end-effectors which have been connected to the hand piece.”

In sum, none of the cited references, neither individually nor in combination, teach the or suggest a generator that “instructs a hand piece to operate in different modes based on a handicap

limit and a disable limit for all end-effectors which have been connected to the hand piece," as set forth in amended independent claims 1-3, 9, 10, 12, 32, and 44. In view of this, Applicants respectfully assert that the amended independent claims are patentable over the combination of the cited references.

In light of the patentability of independents claim 1-3, 9, 10, 12, 32, and 44, for the reasons above, dependent claims 4-8, 11, 13-31, 33-43, and 45-46 are also patentable over the prior art.

Based on the foregoing amendments and remarks, this application should be in condition for allowance. Early passage of this case to issue is respectfully requested. However, if there are any questions regarding this amendment, or the application in general, a telephone call to the undersigned would be appreciated since this would expedite the prosecution of the application for all concerned.

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Respectfully submitted,

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